

# Notice of Allowability

Application No.

10/524,919

Examiner

Robert B. Mondesi

Applicant(s)

GIACCIA ET AL.

Art Unit

1652

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed July 31, 2007.
2. ☒ The allowed claim(s) is/are 34-41 and 43-45.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

## DETAILED ACTION

### *Status of the Claims*

**Claims 1-33** have been canceled. **Claims 34-46** are new and have been added. **Claims 34-46** are currently pending. **Claims 34-41 and 43-45** are rewrites of previously examined **claims 9-13** and had been previously subjected to examination; however:

Newly submitted **claims 42 and 46** are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: **claims 42 and 46** are drawn to a method of administering a full length *DEC1/Sra13* or a truncated *DEC1/Sra13* comprising a basic helix loop helix domain to a patient in a therapeutically-effective amount, classified in class 514, subclass 2; whereas the instantly examined and elected claims are drawn to a method of inhibiting adipogenesis comprising contacting in a cell a full length *DEC1/Sra13* or a truncated *DEC1/Sra13* comprising a basic helix loop helix domain classified in class 435, subclass 7.1., see restriction requirement mailed December 19, 2006.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, search and divergent subject matter restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, **claims 42 and 46** are withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with William E. Beaumont on November 27, 2007.

The application has been amended as follows:

**Claim 35** (Currently amended) The method of claim 34, wherein the truncated polypeptide has an the amino acid sequence of amino acids 1-141 of SEQ ID NO:2.

**Claim 36** (Currently amended) The method of claim 34, wherein the truncated polypeptide has an the amino acid sequence of amino acids 1-141 of SEQ ID NO:4.

**Claim 37** (Currently amended) The method of claim 34, wherein the truncated polypeptide further comprises a peptide having an the amino acid sequence of SEQ ID NO: 7.

**Claim 38** (Currently amended) The method of claim 35, wherein the truncated polypeptide further comprises a peptide having an the amino acid sequence of SEQ ID NO:7.

**Claim 39** (Currently amended) The method of claim 36, wherein the truncated polypeptide further comprises a peptide having an the amino acid sequence of SEQ ID NO:7.

This application is in condition for allowance except for the presence of **claims 42 and 46** directed to an invention non-elected without traverse (Election was made **without** traverse in the reply filed on June 6, 2007, see page 2, lines 13-15).

Accordingly, **claims 42 and 46** have been cancelled.

#### **REASONS FOR ALLOWANCE**

The following is an examiner's statement of reasons for allowance: The outstanding rejections in the non-final office action mailed July 31, 2007 were directed to issues with regards to 35 U.S.C 112 first and second paragraph, as the invention had been determined to be free of prior art. Applicants have since amended the claims though the submission of new claims and have overcome issues with regards to the mentioned rejections. Therefore the subject matter of the claimed method of the instant application is found to be allowable since it is not anticipated or rendered obvious by the disclosure of the prior art and complies with the requirements of 35 U.S.C 112 first and second paragraph.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

**Claims 34-41 and 43-45** are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert B Mondesi/  
Examiner  
Art Unit 1652  
January 7, 2007